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| 09/284,983      | 05/11/1999  | D. LEE MANNER        | T8463488US          | 3065             |

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COMMERCE COURT WEST  
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TORONTO, M5L1J3  
CANADA

EXAMINER

CLARKE, SARA SACHIE

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/284,983

**Applicant(s)**

MANNER, D. LEE

**Examiner**

Sara Clarke

**Art Unit**

3743

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 May 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 19, 22 and 27-38 is/are pending in the application.

4a) Of the above claim(s) 37 and 38 is/are withdrawn from consideration.

5) Claim(s) 19, 22 and 27-33 is/are allowed.

6) Claim(s) 34-36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 34-36, line 5, it is unclear how Applicant defines what is "coarse." The specification provides no guidance as to how "coarse" would be measured.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Naples (US 3279900).

For claims 34-36, Naples discloses the invention as claimed including a pad 1 made from a cellulosic pulp and saturated (see the patent claims) with wax. Since the pad is packaged in a container 4, is shipped, and received from a store (see col. 2, lines 58-63), the paraffin is necessarily in a hardened state after the pad 1 is treated with it.

However, to the extent that the product-by-process limitations necessarily distinguish the invention from the prior art, the examiner has noted that the applicant's specification does not set forth that such differences unexpectedly solve some problem in the art nor unexpectedly provide some new result when compared with the applied art. Accordingly, such differences appear to be a mere matter of design choice. ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP §2113 quoting *In re Thorpe, et al.*, 227 USPQ 964, 966 (CAFC 1985))

#### ***Allowable Subject Matter***

Claims 19, 22, and 27-33 are allowable.

With respect to claims 27-33, the examiner found various references, such as Naples, cited above, that teach saturating the porous carrier with the liquefied solid fuel. However, the examiner was not able to find a reference that teaches a *reason or motivation* to modify the process of Strickman so that instead of being dipped the porous carrier is impregnated "with a liquefied solid fuel such that the liquefied solid fuel is dispersed throughout the porous carrier."

#### ***Response to Amendments and Arguments***

Applicant's arguments with respect to claims 34-36 have been considered but are

moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rutherford (US 2007694) disclose soaking cut blocks of vegetable fiber board with paraffin.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Clarke whose telephone number is (703) 308-1388. The examiner can normally be reached on M-Thurs, 8:30-5:00, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application is assigned are (703) 305-3463 for regular communications and (703) 308-7764 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0861.

  
Sara Clarke  
Primary Examiner  
Art Unit 3743

January 13, 2002